

REMARKS

Claims 1-19 are pending in the application. The applicant gratefully acknowledges the examiner's indication that claims 16 and 17 contain allowable subject matter. However, the applicant respectfully requests reconsideration of the rejection of claims 1-15 and 18-19.

Claim Rejections Under 35 U.S.C. § 103(a)

The applicant respectfully traverses the examiner's rejection of claims 1-15, and 18-19 as obvious over Aggarwal, U.S. Patent No. 6,239,867 in view of Newman et al., "a multimedia solution to productivity gridlock: a re-engineered jewelry appraisal system at Zale Corporation," MIS Quarterly v. 18 n. 1, 3/1994.

A declaration by the applicant Peter J. Malnekoff pursuant to 37 C.F.R. § 1.131 ("the Rule 131 Declaration") is filed herewith. The Rule 131 Declaration demonstrates that the invention claimed in this application was conceived by Mr. Malnekoff prior to May 28, 1998, and that Mr. Malnekoff and that he was reasonably diligent in reducing the invention to practice. As will be set forth in further detail below, the subject matter disclosed in Aggarwal that is relied upon by the examiner in rejecting the claims of this application does not have support in the provisional application Serial No. 60/068,033, filed on December 18, 1997, upon which the Aggarwal patent claims priority (a copy of the file history of the aforementioned Aggarwal provisional application is attached hereto as Exhibit A¹). Accordingly, the Rule 131 Declaration serves to swear behind the Aggarwal reference.

In the final office action, the examiner relies upon portions of Aggarwal in rejecting the applicant's claims that are not supported in the Aggarwal provisional patent application.

¹ It is noted that Fig. 10 of the Aggarwal provisional patent application is missing from the attached exhibit, as it was not available at the time the applicant obtained the copy of the Aggarwal provisional application file history. However, from the text of the Aggarwal provisional application it is evident that Fig. 10 was related to the optical apparatus of the Aggarwal invention, and not pertinent to the applicant's claims in the present application.

For example, in rejecting the applicant's claims 1-15 and 18-19, the examiner relied upon Aggarwal's teaching of "the intended use of general query of the database for current market price information (col. 16, lines 25-40, claims 31, 34, 35)." This disclosure material relied upon by the examiner from the Aggarwal patent is entirely absent from the Aggarwal provisional patent application. Similarly, the Aggarwal provisional application does not disclose or suggest a processing device adapted to compute a pricing estimate for use in an evaluation report based upon gemstone data received, as the text cited by the examiner at col. 16, lines 25-40 and at claims 25-26, and 31 of the Aggarwal patent find no support in the Aggarwal provisional application. Accordingly, the effective date of such teachings of Aggarwal do not extend back to the filing date of the Aggarwal provisional application (December 18, 1997), but instead only are entitled to an effective date of May 28, 1998, the filing date of the nonprovisional application from which the Aggarwal reference is a continuation.

In light of the foregoing, the rejections based upon Aggarwal have been overcome by the Rule 131 Declaration submitted herewith. Accordingly it is respectfully submitted that the rejection of claims 1-15, and 18-19 as obvious over Aggarwal in view of Newman has been overcome and should be withdrawn.

Applicant gratefully acknowledges the courtesies extended by the examiner during a telephonic interview conducted between the applicant, applicant's counsel, Gregory C. Mayer and Thomas I. Ross, and the examiner on June 9, 2003. During the interview, the Aggarwal reference and the Newman reference were discussed, and the applicant and applicant's counsel pointed out to the examiner that both references required the presence of a gemstone, and do not use predetermined data. It was further pointed out to the examiner that the "database" of Aggarwal is only used to check if identical gemstones have been analyzed.

Unfortunately, agreement was not reached, and it became clear to applicant and applicant's counsel that it would be necessary for the applicant to swear behind the Aggarwal patent.

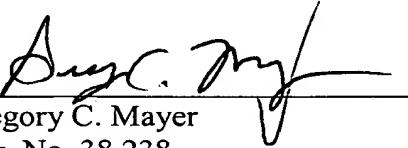
Accordingly, and as noted in the Remarks section of the applicant's Amendment "A" filed on November 12, 2002, as being a possible necessity in the event that the examiner persists in the rejections based on prior art such as Aggarwal, the applicant has now presented the Rule 131 Declaration with appropriate documentary evidence swearing behind the Aggarwal patent. It is submitted that this Rule 131 Declaration is timely, even though presented after a final rejection, because the applicant and applicant's counsel reasonably believed that the non-final rejection of pending claims based in part on the Aggarwal reference could be overcome by pointing out to the examiner that the obviousness rejection of the pending claims based on Aggarwal and Newman were improper on the merits, regardless of whether Aggarwal was a proper prior art reference under 35 U.S.C. § 102(e). It was only after receiving the final rejection and discussing the same with the examiner during the telephonic interview that it became evident that the submission of a Rule 131 declaration, a time-consuming and costly endeavor, would be necessary to overcome the examiner's claim rejections based upon the Aggarwal reference.

Conclusion

It is respectfully submitted that this application is now in condition for allowance. Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application towards allowance, she is respectfully invited to contact the undersigned attorney at the indicated telephone number.

Respectfully submitted,

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